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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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THE LAW OFFICE OF THOMAS M. ISAACSON
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EXAMINER

RODRIGUEZ, CRIS LOIREN

ART UNIT PAPER NUMBER

3763

DATE MAILED: 07/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/693,082

Applicant(s)

SIBBITT, WILMER L.

Examiner

Cris L. Rodriguez

Art Unit

3763

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-60 is/are pending in the application.
- 4a) Of the above claim(s) 1-34, 39-48 and 51-60 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 35-38, 49 and 50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's arguments filed May 18, 2006 with respect to the rejection(s) of the claims under 35 USC 102 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Marsden.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 37, 38, 49, and 50 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claim 37, 38, 49, and 50 are indefinite because the scope of the claims is not clear in such a way on what the words "butterfly" and "moth" encompasses since there are hundreds of species of butterflies and moths. The word "resemble" is broad and encompasses shape, thickness, color, form, etc., and applicant has not specified which one of these characteristics wants to be considered in the claims. Moreover, the fact that applicant has claims directed to wings resembling a "moth" or "butterfly" suggests that there is a difference between both of them, as supported by applicant's disclosure and drawings.
- It seems that applicant is trying to invoke 35 USC 112, 6th paragraph in claim 35. Applicant must show that the claim limitation is written as a function to be

performed and does not provide sufficient structure, material, or acts which would preclude application of this section. (See MPEP 2181).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 35-38 and 49-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Firth et al (US 5,501,672) in view of Marsden (US 2004/0143226 A1).

Firth discloses a butterfly needle assembly (figs. 25-27) having a needle 70 with a needle hub 112, wings 108a-108b attached to the shield 110, a locking means 114, and a thumb rest at the upper rear surface of the shield. However, Firth fails to disclose the wings being integral with the needle hub and extending through the side tracks enabling movement of the wings through the side tracks.

Marsden teaches in [0028] that it is known to use the wings either attached to the needle hub (and movable through side tracks) or to the shield. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Firth by providing the wings attached to the hub and tracks to the shield since Marsden suggests that such modification involves only routine skill in the art such as a mere reverse essential working parts which would involve to move one element relative to the other. See *In re Einstein*, 8 USPQ 167.

Response to Arguments

6. Applicant's arguments filed May 18, 2006 have been fully considered but they are not fully persuasive.

- With respect to arguments about that figures 11A-12B is similar figures 8A-8B, the examiner disagrees because figure 8A has a recess 818 that is different from the tab (no reference numeral assigned) shown in figure 12B. The examiner withdrew the objection to the drawings upon further review of figures 12A-12B. Furthermore, Figure 8A does not show a locking device, but an alternative in figure 8B (see disclosure).
- With respect to arguments about the "breadth of a claim", the examiner disagrees. If the claim is too broad because it does not set forth that which applicants regard as their invention as evidenced by statements outside of the application as filed, a rejection under 35 USC 112 2nd paragraph, would be appropriate (MPEP 2173.04). The scope of claim 35 is not clear. See rejection above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cris L. Rodriguez whose telephone number is 571-272-4964. The examiner can normally be reached on 7:30 am - 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nick Lucchesi can be reached on 571-272-4977. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3763

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

July 16, 2006



Cris L. Rodriguez
Primary Examiner
Art Unit 3763